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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/135,059	10/12/93	SEEBACHER R	233808419

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DARBY & DARBY
805 THIRD AVENUE
NEW YORK NY 10022

EXAMINER	
PITTS, A	
ART UNIT	PAPER NUMBER
3502	18

DATE MAILED: 05/08/97

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

See the attached Office action.

Office Action Summary	Application No. 08/135,059	Applicant(s) Seebacher
	Examiner Andrea L. Pitts	Group Art Unit 3502

☒ Responsive to communication(s) filed on *Apr 2, 1997* .

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-70* is/are pending in the application.

Of the above, claim(s) *20, 23, 28, 31-35, and 48-68* is/are withdrawn from consideration.

☒ Claim(s) *36-47 and 70* is/are allowed.

☒ Claim(s) *1-19, 21, 22, 24, and 69* is/are rejected.

☒ Claim(s) *25-27, 29, and 30* is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

This is a first Office action in response to applicant's first submission under 1.129(a) filed April 2, 1997.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1-8, 18, 19, 21, 22, 24 and 69 are rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent 54-145860.

The Japanese Patent '860 discloses a torque converter with a lockup clutch including all of the elements as set forth in applicant's claim, specifically including a housing 6 connected with a rotary driving device (shaft) 1, 2; a runner 10 disposed in the housing and connected to a rotary driven device (shaft) 13 via hub 12; a carrier (hub) 26 connected to the runner 10 by a weld for rotating therewith; a torsionally elastic damper means 25 for transmitting power between the housing 6 and the driven device 13, wherein the torsion elastic damper means includes at least one energy

storing device spaced apart from and disposed radially outwardly of the axis of rotation X-X and is acting in a circumferential direction of the impeller 8 and is in a power flow between the runner 10 and the driven device 13 via hub 12 and piston 15 when the clutch is in a locked up condition. The Japanese Patent also includes a guide wheel 11; said driving device 1 which includes an output element 2 of an engine; said driven device 13 which includes an input element of a transmission; and said housing which includes a wall 6 adjacent the driving device 2, wherein the power transmitting device is disposed between the wall and the runner 10. The damper further includes an output member (piston) 15 which is axially movable and an output element 21 arranged to transmit torque to the driven device 13 which is nonrotatably connected with an output member.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed

invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 9 and 10 are rejected under 35 U.S.C. § 103 as being unpatentable over Japanese Patent 54-145860.

The Japanese Patent discloses all of the limitations as set forth in applicant's claims as noted in the rejection under 35 USC 102(b) except there is no indication of the spring gradient of the preformed curved springs 20. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to determine the optimum range of the spring gradient, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller,* 105 USPQ 233.

Claims 11-17 are rejected under 35 U.S.C. § 103 as being unpatentable over Japanese Patent 54-145860 in view of Friedmann et al. 5,377,796.

The Japanese Patent does not disclose the wear resistance member or a torsion damping spring preformed in a curved shaped wherein the springs extend along an arc between 75° and 175°.

However, Friedmann et al. discloses the wear resistance member 23 and the torsion damping spring 20 which is preformed into a curved shape and extends along an arc between 90o and 175o.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to apply Friedmann et al.'s teaching of the damping spring to the Japanese Patented invention for providing a damper with enhanced energy storing capabilities.

Allowable Subject Matter

Claims 25-27, 29 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 36-47 and 70 are allowable over the prior art of record.

The following is an Examiner's statement of reasons for the indication of allowable subject matter: the prior art of record does not reveal or render obvious a power transmitting apparatus having all of the elements as set forth in the independent claim specifically including the combination of the stressing means for stressing the elastic damper which is connected with a runner for joint movement about and along the axis, wherein the runner is connected with a rotary driven device and is movable relative to the output element in the direction of the axis. The prior art further does not

render obvious an engageable and disengageable bypass clutch in series with the damper such that the energy storing element is operative to transmit torque between the runner (rotor) and the driven device in the disengaged condition of the clutch.

Response to Amendment

Applicant's arguments filed April 2, 1997 have been fully considered but are not deemed to be fully persuasive.

The Examiner agrees with Applicant that the Toyota reference does not disclose a torque transmission power flow path from the turbine to the damper and then to the output hub when the bypass clutch is disengaged. However, the Toyota reference does disclose such a power flow when the bypass clutch is in an engaged condition.

With respect to the above rejected claims, there is no limitation that the clutch is in a disengaged state as stated by Applicant (paper #17, page 5, second paragraph). Such subject matter is not introduced until claim 25. Applicant further states (page 6, second paragraph) that the Toyota reference cannot transmit torque from the turbine to the input shaft, but only to the turbine when the bypass clutch is engaged. However, twice amended claim 1 does not specify the direction of power flow only that the impeller is in a "power flow between said at least one runner and said driven device." Therefore, giving the claim the broadest reasonable interpretation, the claim must

include the engaged state of the bypass clutch and the claims are not deemed patentable over the prior art.

Conclusion

This is a continuation of applicant's earlier Application No. 08/135,059. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

Since the fee set forth in 37 CFR 1.17(r) for a first submission subsequent to a final rejection has been previously paid, applicant, under 37 CFR 1.129(a), is entitled to have a second submission entered and considered on the merits if, prior to

abandonment, the second submission and the fee set forth in 37 CFR 1.17(r) are filed prior to the filing of an appeal brief under 37 CFR 1.192. Upon the timely filing of a second submission and the appropriate fee of $770.00 for a large entity under 37 CFR 1.17(r), the finality of the previous Office action will be withdrawn. If a notice of appeal and the appeal fee set forth in 37 CFR 1.17(e) were filed prior to or with the payment of the fee set forth in 37 CFR 1.17(r), the payment of the fee set forth in 37 CFR 1.17(r) by applicant will be construed as a request to dismiss the appeal and to continue prosecution under 37 CFR 1.129(a). In view of 35 U.S.C. 132, no amendment considered as a result of payment of the fee set forth in 37 CFR 1.17(r) may introduce new matter into the disclosure of the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea L. Pitts whose telephone number is (703) 308-2159.

ANDREA L. PITTS
PRIMARY EXAMINER
GROUP 3500

alp

May 6, 1997